

Application No.: 09/866,652
Inventor: Tommaso Innocenti

Art Unit: 3624

Examiner: Charles R. Kyle
Filed: May 30th 2001

REQUEST FOR CONTINUED EXAMINATION UNDER 37 C.F.R. § 1.114

A. Grounds for and Request Under 37 C.F.R. § 1.114

1. Applicant respectfully submits that:

a. the last Office action in examination of the present application for patent was made final; hence

b. under 37 C.F.R. § 1.114(b), prosecution in said application is closed as used in 37 C.F.R. § 1.114; and

c. under 37 C.F.R. § 1.114(a) "applicant may request continued examination of the application by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of: (1) Payment of the issue fee, unless a petition under § 1.313 is granted; (2) Abandonment of the application; or (3) The filing of a notice of appeal".

2. Applicant respectfully requests continued examination under 37 C.F.R. § 1.114 and submits that the present request is being filed with a submission and the fee set forth in 37 C.F.R. § 1.17(e) prior to payment of an issue fee, abandonment of the present application, and filing of a notice of appeal.

3. Applicant respectfully submits that submission filed herein comprises:

a. Preliminary Amendment effecting the modification of language proposed prior interview and incorporation of original claims 26 & 33 into new base claim 40;

b. Interview Summary;

c. Identification of Support in Specification for Amendment;

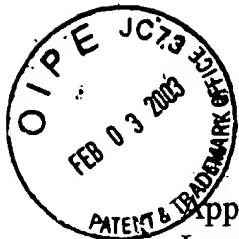
d. Submission of Evidence Overcoming Grounds of Rejection; and

e. Summary and Request for Allowance.

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B. Submission of Evidence Overcoming Grounds of Rejection

1. Applicant respectfully submits that the second Office action contained no support for rejection specific to original claim 26, that as set forth on page 3 of the 'Interview Summary' attached hereto, the second Office action states that *Auction This* and *Wurman*:

do not specifically disclose providing samples of a commodity by a seller (but) *Palmer* discloses this feature at page 8 (and it) would have been obvious to one of ordinary skill ... for the seller to provide samples of auction ... because this would have allowed bidders and sellers to adjust commodity pricing to reflect quality as specifically taught by *Palmer* at page 8 (SOA, p. 7, top);

but there was no support given in rejection of original claim 26; only the rejection itself: "Claims 26 - 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Auction This* and *Wurman* in view of *Forage Buy-Sell Contracts* by *Palmer*." (SOA, page 6, bottom)

2. Applicant respectfully submits that any argument in support of the restriction imposed by original claim 26 relying upon the principle that the provision of a model by a prospective buyer is equivalent to, or obvious in view of, the provision of a sample by a prospective seller, i.e. that support of rejection of original claim 33 provides grounds for rejection of original claim 26, is without grounds because, as specifically established during interview between the present Applicant's representative and the present Examiner as recorded on page 5 of the summary of the same attached hereto, Applicant's representative: "indicated that it was desired that the written summary of the present interview specifically state that a model is different than a sample because it is provided by a prospective buyer, not a prospective seller".

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1 3. Applicant respectfully submits that the provision of a model of a particular commodity
2 by a prospective buyer is undisclosed by the prior art cited in support of rejection made final.
3

4 4. Applicant respectfully submits that Examiner tacitly admitted during interview that
5 the prior art of record fails to either disclose or suggest the provision of a model of a
6 particular commodity by a prospective buyer in indicating "that the prior art would have to
7 be searched again to determine whether (the same) was known to the prior art or not"
8 (Interview Summary, page 4, second paragraph).
9

10 5. Applicant respectfully submits that the provision of a model of a particular commodity
11 by a prospective buyer is not obvious in view of provision of a sample by a prospective seller
12 because while the prospective seller must have a particular commodity in order to offer the
13 same for sale at auction a prospective buyer can only review the offerings in auction and bid
14 accordingly, that while bids are expected to reflect the quality perceived in the offerings, this
15 intrinsic mechanism wherein "bidders and sellers" "adjust commodity pricing to reflect
16 quality" (SOA, page 7 lines 6 - 7), teaches away from a prospective buyer providing a model
17 of the commodity quality desired as evidenced by the term 'bidder' which restricts their
18 action to bidding and their determination of quality to inspection of the material for sale.
19

20 6. Applicant respectfully submits that, as indicated by Applicant's representative during
21 interview, *in re Vaeck* precludes searching of the prior art "for an element or modification
22 of elements suggested by the disclosure of the applicant rather than the prior art", (Interview
23 Summary, page 4, second paragraph) and respectfully recites from the MPEP in support

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thereof:

2143 Basic Requirements of a *Prima Facie* Case of Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

7. Applicant respectfully submits that the restriction imposed by original claim 26 comprises a claim limitation that was neither taught nor suggested by the prior art of record, that the "teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure" as required by the MPEP in referencing *In re Vaeck*, and since Applicant's representative during interview specifically identified the restriction of original claim 26 as being absent from the prior art and providing a claimed limitation patentably distinguishing the present invention over the prior art of record, any 'teaching or suggestion to make (this) claimed combination' following this interview would be improperly found in applicant's disclosure because, as clearly emphasized in the MPEP: **"2143.01 Suggestion or Motivation To Modify the References / THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION"**.

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1 8. Applicant respectfully submits that MPEP 2143.01 clearly states, in citation of *In re*
2 *Rouffet* wherein "(t)he combination of references taught every element of the claimed
3 invention, however without a motivation to combine, a rejection based on a *prima facie* case
4 of obvious(ness) was held improper", and therefor if a search of the prior art following
5 interview discovers a reference teaching the restriction of original claim 26, now a limitation
6 of present base claim 40 and hence a claimed limitation to all of the present invention, this
7 reference can not be combined with other prior art if the motivation to combine is derived
8 from the applicant's disclosure as specifically prohibited by MPEP 2143 in reference to *In*
9 *re Vaeck*.

10
11 9. Applicant respectfully submits that hindsight of applicant's disclosure, particularly
12 the provision of a model by a prospective buyer because this claim limitation was
13 specifically identified by Applicant's representative during interview with Examiner, is
14 forbidden by U.S. patent law because: "it is entirely improper to ask whether the invention
15 'is' or 'would be' obvious; the question is whether it 'would have been obvious'" as the
16 Examiner:

17
18 now knows all about the invention; he must determine whether it would have
19 been obvious to those who knew only about the prior art.³³ He must view the
20 prior art without reading into it (Applicant's) teachings.³⁴ And although the
21 person skilled in the art is presumed to know the art - indeed, he is pictured as
22 working in his shop with the art hanging on the walls around him - the art in
23 question is only that which he would have selected without the advantage of
24 hindsight or knowledge of the invention.³⁵ (Robert L. Harmon, *Patents and the*
25 *Federal Circuit*, BNA Books, Washington, D.C., 1991, pp. 78-79 referencing:
26 ³³*Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed.
27 Cir. 1985); *Rosemount, Inc. v. Beckman Instruments, Inc.*, 727 F.2d 1540, 221

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1 USPQ 1 (Fed. Cir. 1984); ³⁴*Vandenberg v. Dairy Equipment Co.* 740 F.2d
2 1560, 224 USPQ 195 (Fed. Cir. 1984); *Kansas Jack, Inc. v. Kuhn*, 719 F.2d
3 1144, 219 USPQ 857 (Fed. Cir. 1983); ³⁵*Union Carbide Corp. v. American*
4 *Can Co.*, 724 F.2d 1567, 220 USPQ 584 (Fed. Cir. 1984).);
5

6 and therefore, in brief, “(h)indsight is a tempting but forbidden zone” (*Ibid.*, p. 78,
7 referencing *Locktite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 228 USPQ 90 (Fed. Cir. 1985),
8 as further recognized in MPEP 2141: “(w)hen applying 35 U.S.C. 103, the following tenets
9 of patent law must be adhered to: ... (C) The references must be viewed without the benefit
10 of impermissible hindsight afforded by the claimed invention”.
11

12 11. Applicant respectfully emphasizes that Examiner is bound by the tenets of U.S. patent
13 law and can not legally:

- 14 a. employ hindsight of the claimed invention in review of the prior art; or
15 b. use applicant’s disclosure as the “teaching or suggestion to make the claimed
16 combination” as clearly stated in MPEP 2143 in citation of *In re Vaeck*;
17 regardless of whether Examiner, as indicated during interview, is unfamiliar with *In re Vaeck*
18 or the legal prohibition referenced thereby during interview.
19

20 12. Applicant respectfully submits that as Examiner admitted that the prior art of record
21 did not disclose the option of a prospective buyer providing a model as an indication of the
22 quality sought and Applicant’s representative specifically identified this element as a claim
23 limitation patentably distinguishing the presently claimed invention over the prior art, it is
24 not possible now for Examiner to combine prior art references or modify any of the same to
25 allege that the presently claimed invention is obvious in view of the prior art because any

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1 such combination or modification now, following interview, would necessarily improperly
2 and illegally be using Applicant's disclosure as the motivation for the same in addition to
3 comprising improper and illegal use of hindsight in review of the prior art.
4

5 13. Applicant respectfully submits, in anticipation of any improper rejection of present
6 base claim 40 based upon the argument that a provision of a sample by a prospective seller
7 suggests provision of a model by a prospective buyer, "(t)hat which may be inherent is not
8 necessarily known (and) (o)bviousness cannot be predicated on what is unknown" (Robert
9 L. Harmon, *Patents and the Federal Circuit*, BNA Books, Washington, D.C., 1991,, p. 92,
10 referencing *In re Newell*, 891 F.2d 731, 218 USPQ 769 (Fed. Cir. 1983)) and hence, even
11 if provision of a model by a prospective buyer is considered to be inherent to the provision
12 of a sample by a prospective seller, the fact that the former was unknown to the prior art at
13 the time of invention precludes obviousness.
14

15 14. Applicant respectfully submits that the Preliminary Amendment attached hereto
16 overcomes the grounds of rejection conveyed and made final in the second Office action in
17 the present application for patent by incorporating the restriction imposed by original claim
18 26, together with that of original claim 33, into new base claim 40 because said restriction:
19 "providing the option of provision of a model of a particular commodity desired for purposes
20 of indicating the quality desired by a prospective buyer" comprises a patentable distinction
21 that is neither disclosed nor taught nor suggested by the prior art cited in support of said
22 rejection and hence comprises a claimed limitation, in the language of the base claim,
23 patentably distinguishing the present invention over the known prior art.

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C. Summary and Request for Allowance

1. Applicant respectfully submits that the present request for continued examination has been timely filed and all requirements of the same fulfilled as set forth in section A above including the required fees and a full and proper submission.

2. Applicant respectfully submits that the Preliminary Amendment filed herewith neither enlarges the scope of the claims as originally filed nor introduces any new matter and further that said amendment, as evidenced by the Identification of Support in Specification for Amendment attached hereto, is fully supported by the original specification as filed.

3. Applicant respectfully submits that the incorporation of the restriction upon the presently claimed invention imposed by original claim 26 into new base claim 40 by preliminary amendment in continued examination overcomes the grounds of rejection made final in examination of the present application for patent as evidenced by:

- a. the lack of any support specific to rejection of original claim 26;
- b. examiner's admission during interview that the prior art of record failed to disclose the restriction of original claim 26;
- c. the prior art teaching away from the restriction of original claim 26.

4. Applicant respectfully submits that the language incorporating the restriction imposed by original claim 26 into new base claim 40 by amendment has been specifically pointed out in the above with regard to how the language of the claims distinguishes the claimed invention over the references relied upon in rejection in accordance with 37 CFR 1.11(b),


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1 and further that the restriction imposed by this language has been clearly pointed out in the
2 above as the patentable novelty presented by the claims in view of the state of the art
3 disclosed by said references and the same shown to avoid said references in accordance with
4 37 CFR 1.11(c).
5

6 6. Applicant respectfully submits that the impropriety of either combining or modifying
7 prior art references to suggest the claimed restriction imposed by original claim 26 now
8 incorporated by amendment into present base claim 40 in support of rejection, particularly
9 now following interview in which said restriction was specifically identified by Applicant's
10 representative as distinguishing the present invention over the prior art and Examiner tacitly
11 admitted the absence of this limitation in the prior art in indicating that further searching
12 would be necessary to determine this, has been established in the above in discussion of the
13 impermissible use of hindsight with reference to the MPEP and governing patent law with
14 particular regard to the present examination.
15

16 7. Applicant respectfully submits that, for all of the reasons presented above, the present
17 application is in full and proper condition for allowance which action is further humbly and
18 respectfully requested.
19

20 Respectfully and sincerely yours,

21 
22 Peter Gibson, Reg. #34,605
23